

Docket No.: 60409.300903

Patent

REMARKS

It is our understanding that claims 1-26 remain pending in this application. We proceed now with reference specifically to the numbered items in the Action.

Item 1 (Claim Status):

This appears informational in nature and is understood to require no reply.

Item 2 (Part 1/4: Arguments Found Persuasive):

We thank the Examiner for the indications here. These also appear informational in nature and are understood to require no reply.

Item 2 (Part 2/4: Arguments Not Found Persuasive, generally):

The Action here states "*Arguments regarding claims 1-3, 6-9, 14-16, 19-22 are found to be non-persuasive.*" However, since claims 1-26 are actually pending, this would appear to mean that our arguments were actually persuasive regarding claims 4-5, 10-13, 17-18, and 23-26. The present Action fails to indicate whether this is so for claims 5, 10-13, 17-18, and 23-26.

We respectfully ask the Examiner to clearly state whether the § 102(b) and the § 103(a) rejections of claims 5, 10-13, 17-18, and 23-26 are withdrawn.

Item 2 (Part 3/4: Arguments Not Found Persuasive; § 102(b) rejections):

The Action here states:

Claim 1***Applicant Primarily Argues***

Our point now is that this has Tamura's 62-bit wide packet (Fig. 2 and col. 4, In 32-33) being regarded as equivalent to Applicant's search value.

Examiners Response

Applicant's arguments fail to comply with 37 CFR 1.111(b) because they amount to a general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references.

Something was apparently missed here. A prima facie case under § 102(b) requires that a reference teach all of the claim elements. Applicant has argued that its particular search value, and the various particular elements that work with it in claim 1, are not taught by Tamura. The

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sentence quoted from our last Response summarizes this and the rest of the paragraph that it was taken from and the seven paragraphs after it discuss this with specificity. Applicant's argument therefore directly discusses why the language of the claims patentably distinguishes them from the reference.

The Action next states:

Applicant Primarily Argues

One of ordinary skill in the art will readily appreciate that a FIFO memory is unsuitable to store a search engine database that necessarily is addressably accessed.

Examiners Response

Plain ordinary meaning of the claimed limitation as governed by MPEP 2111.01 of "—a memory to store a search database of said search results and provide instances of said search results to said controller", is covered by Examiners citation of the reference applied. The allegation that such a memory as cited by the Examiner is not suitable for Applicant's purposes or "addressably accessed" is not found in the claim and therefore non-persuasive.

Something was also apparently missed here. Applicant's point was and remains that claim 1 recites a search database, the cited to Tamura teaches a FIFO memory, FIFO memories are unsuitable to store search databases, therefore Tamura does not teach a search database. What claim 1 recites and what Tamura teaches would seemingly be beyond dispute and the Examiner has not rebutted Applicant's assertion (about FIFO memory suitability).

As for the statement that "*The allegation that such a memory as cited by the Examiner ... is not found in the claim ...*," we doubt that this was what the Examiner meant to say, since it would be nonsensical for a claim to recite an element that does not work. As for this same sentence parsed as "*The allegation that such a memory ... [is not] ... 'addressably accessed' is not found in the claim ...*," it appears that the claim has not been interpreted as a whole. Claim 1 recites that the hash-CAM, specifically the logic unit therein, creates an address value and provides that to the memory for searching the search database stored therein. One of ordinary skill in the art will readily appreciate that using an address value to search in a memory is addressably accessing that memory.

The Action then next states:

Examiners Response

The rest of Applicants' arguments regarding claim 1 as above are directed to the preferred embodiment of Tamura's invention, and while providing differences between Applicant's invention and Tamura's, these

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argument are not in commensurate scope with the claimed limitations rendering them moot.

Respectfully, Applicants' arguments were directed to what Tamura teaches, specifically those portions that the Examiner himself chose to cite in support of the rejection. We thank the Examiner for conceding that we have "*providing differences between Applicant's invention and Tamura's.*"

As for the Examiner's conclusion about scope, it is unsupported with any details and thus does not afford Applicant a reasonable opportunity for reply. And as for mootness, unless the Examiner is withdrawing the rejection Applicant's arguments cannot be moot. The Examiner has either failed to express himself as intended or needs to contemplate the definition of "moot": "*A subject for argument; unsettled; undecided. A moot point is one not settled by judicial decisions.*" (Black's Law Dictionary)

Moving on, the Action states:

Claim 2

Applicant Primarily Argues

We can find no clear support for such in the cited portion of Tamura. Fig. 4, especially Fig. 5, and the text all clearly indicate that Tamura's address generator 101 is a simple exclusive-OR unit.

Examiners Response

Examiner finds no basis for these arguments from the claimed limitations. Further the cited portion of Tamura's specification says

As described above, in accordance with the present invention, generation of the hashed address is performed by a predetermined reversible logical or arithmetic operation. (Column 12, lines 52-55)

which provides for a multitude of hash functions including the exclusive-OR.

However, again Applicants' arguments were directed to what Tamura teaches (or here, does not teach but was asserted to teach). Claim 2 recites that Applicant's hash unit is programmable. That is the claim limitation at issue. Applicants' arguments were that Tamura does not teach programmability in the cited portion or elsewhere (such as its teaching of its XOR type address generator, discussed outside the cite used by the Examiner).

The Examiner now quotes "*predetermined reversible logical or arithmetic operation*" as apparently implying programmability. Predetermination is not programmability. Mere initial design of a circuit is predetermination, but that by no way means that how the circuit works can be changed programmatically after it is constructed. Reversibility is also not programmability, it

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merely means that for a hash function $h(x)=y$ there is a corresponding function $h'(y)=x$. [Most hash functions are not reversible and many purists even feel that true hash functions by definition are one-way.]

Item 2 (Part 4/4: Arguments Not Found Persuasive; § 103(a) rejections):

The Action here is just plain confusing. In multiple places it says “*Claims 6-9, 19-22*” but the rejections in the last Action were of claims 6-13 and 19-26. The Action here paraphrases Applicant’s argument in the last Response; states that this is moot in view of new grounds of rejection elsewhere in the present Action; and then goes on to remark on Applicant’s argument. Accordingly, Applicant is left unsure if a reply is necessary here. Nonetheless, in a responsive spirit and to clarify things for the record we respond as follows to the Examiner’s remarks.

The Action here states:

Applicant’s arguments do not comply with 37 CFR 1.111(c) because they do not clearly point out the patentable novelty which he or she thinks the claims present in view of the state of the art disclosed by the references cited or the objections made. Further, they do not show how the amendments avoid such references or objections.

The Examiner apparently missed our points. They are two-fold: [1] the Tamura reference does not teach or reasonably suggest what it was relied upon for, and [2] the Examiner’s case law based “*duplication of parts*” argument is flawed.

With respect to [1], a rejection cannot stand if the cited prior art fails to teach or reasonably suggest elements of the claims being rejected. We have shown that the rejection of claims 1 and 14 are flawed because Tamura does not teach or reasonably suggest many claim elements (see e.g., all of the “*Regarding claim 1*” discussion on pages 11-13 of our last Response). The point in this respect in our last Response was that claims 6 and 19 contain many of the same elements as claims 1 and 14 so it follows that a prima facie case for rejection of claims 6 and 19 cannot be made based on Tamura.

With respect to [2], the case law cited does not apply to the facts here because the claimed invention does not use duplicate parts.

In sum, we have shown the claimed invention has patentable novelty because Tamura, neither alone or with the case law relied on to read into it what is not there, teaches or reasonably suggests the claimed invention. As for the amendments, we have not argued that they avoid the prior art. Applicant made them merely to avoid the § 112, ¶2 rejection.

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The Action next states "*While the amendment has been treated for the arguments presented, Examiner notes that no arguments are presented pertaining to the other cited references on UPTO [SIC] form 892.*" Respectfully, it is not appropriate for Applicant to argue references unless they are the basis of a rejection, and Applicant properly has not done so.

Item 3 (New Grounds of Rejections: Double Patenting):

As a preliminary item, since U.S. Pat. No. 6,889,225 is the basis of this rejection Applicant respectfully asks the Examiner to officially make it of record in this case by entering it in a Notice of References Cited (PTO form 892) or an appropriate equivalent.

Claims 1-26 are rejected over claim 1 of the '225 patent under the judicially created doctrine of double patenting.

With respect to claims 4-5, 10-13, 17-18, and 23-26 we see the Examiner's point. We do not agree with it entirely (since the present claims are directed to an entire search engine and the '225 patent claims merely a circuit, potentially, for use with a controller and a memory to construct a search engine), but as a pragmatic matter Applicant now avoids this rejection by providing herewith a terminal disclaimer.

With respect to the rest of the claims, however, we do not agree and Applicant reserves the right to file continuation applications without the above listed claims and to later argue otherwise there (e.g., that the respective instances of claim 1 are distinct, as can be seen, for instance, by comparing FIG. 4 and 8 and noting that only the latter includes a search data storage and comparator).

Item 4 (New Grounds of Rejections: § 102(b)):

Claims 1-3 and 14-16 are again rejected as being anticipated by Tamura. Respectfully this is error.

This is not a new grounds of rejection, other than now confining discussion to claims 1-3 and 14-16 rather than claims 1-5 and 14-18, this appears to be exactly the same as in the prior Action. Applicant has remarked on this above, in discussing the Arguments Not Found Persuasive, and we request reconsideration based on those remarks as well as of our remarks in our prior Response.

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Item 5 (New Grounds of Rejections: § 103(a) part 1/2):

The Action here states "5. *This application currently names joint inventors. In considering*" Applicant responded to this in the Response to the prior Action.

Item 6 (New Grounds of Rejections: § 103(a) part 2/2):

Claims 6-9 and 19-22 are again rejected as being unpatentable (obvious) over Tamura. Respectfully this is error.

The Action here states "*Claims 6-9, 19-22 are considered to be an obvious variation of claims 1-3 ...*" and goes on, essentially, to argue that claims 6-9 and 19-22 are rejected under the same rationale as claims 1-3. Responsive thereto, Applicant's position is that claims 6-9 and 19-22 should be allowable for the same reasons discussed above for claims 1-3, and we respectfully ask for reconsideration in view of those remarks.

Item (unnumbered - Conclusion):

This appears informational in nature and is understood to require no reply.

CONCLUSION

Applicant has endeavored to put this case into complete condition for allowance. Applicant has addressed the Double Patenting rejection by providing a terminal disclaimer herewith (on the following page). It is also thought that the §102 rejections are shown to be unfounded on the prior art reference cited and that the §103 rejections have also been completely rebutted. Applicant therefore asks that all rejections now be withdrawn and that allowance of all claims presently in the case be granted.

Intellectual Property Law Offices
1901 S. Bascom Ave., Suite 660
Campbell, CA 95008

Telephone: 408.558.9950
Facsimile: 408.558.9960

Respectfully Submitted,



Raymond E. Roberts
Reg. No.: 38,597